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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,537	02/19/2002	Raymond Anthony Joao	RJ520	1689

7590 09/14/2004

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EXAMINER

CHANNAVAJALA, SRIRAMA T

ART UNIT	PAPER NUMBER
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2177

DATE MAILED: 09/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/076,537

Applicant(s)

JOAO, RAYMOND ANTHONY

Examiner

Srirama Channavajjala

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The drawings filed on 2/19/2002 are acceptable for examination purpose

### *Priority*

2. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged based on the provisional application SI.No. 60/271,658 filed on 2/27/2001.

### *Oath/Declaration*

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67 identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the provisional application which priority is claimed under 35 USC Section 119(e) and any provisional application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month and year of its filing.

In the Oath/Declaration, claim the benefit under **35 USC Section 119(e)** of any United States provisional application details **omitted**.

Appropriate correction is required.

### *Information Disclosure Statement*

4. The listing of references in the **specification at page 63-65** is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and

MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the examiner on form PTO-892 has cited the references, they have not been considered.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Posa et al, [hereafter Posa] based on non-provisional of provisional application no. 60/219,381, filed on July 19, 2000 in view of Winksy et al, [hereafter Winksy] US Patent No. 5774109.

*If a copy of a provisional application listed on the bottom portion of the accompanying Notice of References Cited (PTO-892) form is not included with this Office action and the PTO-892 has been annotated to indicate that the copy was not readily available, it is because the copy could not be readily obtained when the Office action was mailed. Should applicant desire a copy of such a provisional application, applicant should promptly request the copy from the Office of Public Records (OPR) in accordance with 37 CFR 1.14(a)(1)(iv), paying the required fee under 37 CFR 1.19(b)(1). If a copy is ordered from OPR, the shortened statutory period for reply to this Office action will not be reset under MPEP § 710.06 unless applicant can demonstrate a substantial delay by the Office in fulfilling the*

*order for the copy of the provisional application. Where the applicant has been notified on the PTO-892 that a copy of the provisional application is not readily available, the provision of MPEP § 707.05(a) that a copy of the cited reference will be automatically furnished without charge does not apply.*

7. As to Claim 1 and 11, Posa teaches a system which including 'an apparatus for providing an electronic book' [see Abstract, fig 1], electronic book corresponds to Posa's electronic book as detailed in fig 1;

'a memory device for storing book information' [see fig 1-2, col 5, line 1-7], Posa specifically teaches electronic book including various components such as microprocessor controller, RAM and ROM and like as detailed in fig 2;

'an input device for inputting information regarding a user request for book information' [see fig 1, element 104, col 4, line 28-30], Posa specifically suggests user interface where user inputting information;

'a processing device for processing the user request for book information, wherein the processing device identifies book information to be provided to the user' [col 2, line 66-67, col 3, line 1-4];

'a display device for displaying the book information to the user' [see fig 1-2, element 106 and 220, col 3, line 28-31];

'wherein the processing device processes a reading termination command entered by the user via the input device and further wherein the processing device terminates the presentation of the book information' [col 3, line 1-4, line 13-19], Posa specifically suggests pull down menu where user can select the choice for example terminate sound command, reading termination command and like.

It is however, noted that Posa does not specifically teach 'wherein the processing device at least one of identifiers, records, and stores, a first location, wherein the first location is the location in the book information where the presentation of the book information is terminated'; 'further wherein a subsequent presentation of the book information to the user commences from a second location which is located before the first location in the book information and further wherein the subsequent presentation of the book information includes a presentation of at least a portion of the book information previously presented to the user'.

On the other hand Winksy disclosed 'wherein the processing device at least one of identifiers, records, and stores, a first location, wherein the first location is the location in the book information where the presentation of the book information is terminated' [col 4, line 46-52, col 5, line 21-28]; 'further wherein a subsequent presentation of the book information to the user commences from a second location which is located before the first location in the book information and further wherein the subsequent presentation of the book information includes a presentation of at least a portion of the book information previously presented to the user'[col 5, line 34-46].

It would have been obvious to one of the ordinary skill in the art at the time of applicant's invention to incorporate the teachings of Winksy et al. into recap, summary, and auxiliary information generation for electronic book of Posa because both are directed to electronic book, more specifically Posa is directed to a user controlled

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electronic book where reader to receive recap up to a point designated by reader or, alternatively, allow the reader to finish the book by providing summary, displaying pull down menu, definition of words and like as detailed in col 1, line 50-59, while Winsky is directed to electronic scrolling book, more specifically electronic book machine displaying glossary entries for selected terms, words in the text, further selecting summary of portions of text in response to the user selection [see col 2, line 48-54] and both are from the same field of endeavor.

One of the ordinary skill in the art at the time of applicant's invention to modify Posa's reference, specifically fig 1 to incorporate the Winsky's databases of fig 3, element 20 because that would have allowed users of Posa to select, control or temporarily halt, resume from predetermined information on store in the first, second and third memory locations of the database as suggested by Winsky [see col 5, line 34-46], bring the advantages of users to select specific portions or part of the reference to be displayed, temporarily interrupting the scrolling of text and enable to return of a user to a desired location in the text [see Winsky: 8-10], thus improving the reliability and quality of the system.

8. As to Claims 2 and 12, most of the limitations of this claim have been noted in the rejection of Claim 1,11 above. In addition, with respect to the claimed feature Winsky disclosed 'book information is at least one of page marked, encoded, marked, digitally encoded, analog encoded, digitally marked, analog marked [see col 5, line 8-

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10], time-marked, time-stamped [see col 2, line 1-7], 'frame numbered, and further wherein the processing device processes the first location in conjunction with an amount of book information to be reviewed in order to generate the second location' [col 7, line 39-53].

9. As to Claim 3 and 13, most of the limitations of this claim have been noted in the rejection of Claim 1,11 above. In addition, with respect to the claimed feature Posa disclosed 'at least one of the electronic book, a user device a computer, a personal computer, a laptop computer, a kiosk, an electronic kiosk, a personal digital assistant, a telephone, a cellular telephone, a line connected telephone, a wireless telephone, a digital communication device, a digital telephone, an analog telephone, a video telephone, a videophone, a display telephone, personal communication services (PCS) device, a television, an interactive television, a high definition television, a digital television, and a personal communication device' [see Posa: fig 1-2,col 4, line 28-33, line 41-42, line 60-67].

10. As to Claim 4 and 14, most of the limitations of this claim have been noted in the rejection of Claim 1,11 above. In addition, with respect to the claimed feature Posa disclosed 'book information includes at least one of text information, audio information, video information, audio and video information, and a link to at least one of text information, audio information, video information, audio and video information' [col 4, line 56-67].



11. As to Claim 5 and 15, most of the limitations of this claim have been noted in the rejection of Claim 1,11 above. In addition, with respect to the claimed feature Posa disclosed 'book information is at least one of literature, textbook information, educational information, instructional information, reading material, newspaper materials, and magazine materials' [col 3, line 25-42].

12. As to Claim 6 and 16, most of the limitations of this claim have been noted in the rejection of Claim 1,11 above. In addition, with respect to the claimed feature Posa disclosed 'a receiver for receiving book information which is at least one of transmitted from and downloaded from a central processing computer' [fig 1, Abstract, col 1, line 29-36].

13. As to Claim 7 and 17, most of the limitations of this claim have been noted in the rejection of Claim 1,11 above. In addition, with respect to the claimed feature Posa disclosed 'a transmitter for transmitting a request for book information to a central processing computer' [fig 1, col 4, line 60-67].

14. As to Claim 8, most of the limitations of this claim have been noted in the rejection of Claim 1 above. In addition, with respect to the claimed feature Posa disclosed 'a communication device for facilitating communication between the user and a third party at least one of associated with a central processing computer and associated with another apparatus' [fig 1, col 4, line 60-67].

15. As to Claim 9, most of the limitations of this claim have been noted in the rejection of Claim 1 above. In addition, with respect to the claimed feature Posa disclosed 'third party is at least one of a publisher, a provider, a provider, a textbook publisher, an author, a writer, of the book information' [col 6, line 2-6].

16. As to Claim 10, 19, most of the limitations of this claim have been noted in the rejection of Claim 1,11 above. In addition, with respect to the claimed feature Posa disclosed 'processing device determines whether the user is reading the book information for a first time' [col 1, line 40-47].

17. As to Claim 18, most of the limitations of this claim have been noted in the rejection of Claim 1,11 above. In addition, with respect to the claimed feature Posa disclosed 'facilitating communication between the user and a third party at least one of associated with a central processing compuer and associated with another apparatus, wherein the third party is at least one of a publisher, a provider, a text book publisher, an author, a writer, of the book information' [fig 1, col 1, line 40-47, col 4, line 60-67].

***Claim Rejections - 35 USC § 102***

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

19. Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by Reynolds et al., [hereafter Reynolds], WO 98/18086.

20. As to Claim 20, Reynolds teaches a system which including 'electronic book' [see fig 1], 'a receiver for receiving a user request for at least one of book information' [fig 1, abstract]; 'a download of book information' [fig 3, page 11, line 1-4, line 12-27], Reynolds specifically teaches downloading of information from ibook web pages database as detailed in fig 3], a book information update; 'a book information update' [page 7, line 11-13], Reynolds specifically teaches ibook system have alternate versions, also suggests ibook has editing tool as detailed in fig 6; 'information at least one of from and regarding at least one of a publisher, provider, distributor, author, and writer, of book information' [fig 2, page 7, line 13-16, line 21-24], Reynolds specifically teaches multiple authors may participate in a collaborative efforts to contribute to ibook, 'a request to post notes regarding book information, and a request to retrieve notes regarding book information posted by another user' [page 14, line 30-32, page 15, line 1-12];

'a processor for processing the user request' [page 15, line 16-27];

'a transmitter for transmitting information responsive to the user request to an electronic book associated with the user' [fig 1], Reynolds specifically teaches data network where contributors or users are connected to ibook server [see fig 1, element 22,24];

'wherein the apparatus provides at least one of the transmits the requested at least one of book information' [fig 1, page 5, line 20-24]; 'a download of book information' [fig 3, page 11, line 1-4, line 12-27], 'a book information update, information at least one of from and regarding at least one of a publisher, provider, distributor, author, and writer, of book information' [page 7, line 11-13, line 21-24, page 17, line 5-14]; 'notes regarding book information posted by another user' [col 17, line 10-14]; 'stores notes regarding book information posted by the user' [page 17, line 15-19].

***Conclusion***

**The prior art made of record**

- a. US Patent No. 6633741
- b. US Patent No 5774109
- c. WO 98/18086

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure

- d. US Patent No. 6356287
- e. US Patent No. 5697793
- f. US Patent No. 6496803
- g. US Patent No. 6510235
- h. US Patent No. 6728681
- i. US Patent No 6275142
- j. US Patent No 6195667
- k. US Patent No 5524201
- l. 6712701
- m. 2002/0010593
- n. 2002/0073177
- o. WO 01/18665
- p. WO 98/08344
- q. WO 97/20274
- r. EP0838798

s. Kyong-Ho Lee et al., Standardization aspects of eBook content formats, computer standards and interfaces 24 (2002) pp 227-239.

t. Stefan Gessler et al., PDAs as mobile WWW browsers, computer networks and ISDN systems 28 (1995) pp 53-59.

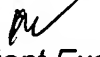
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Srirama Channavajjala whose telephone number is (703) 308-8538. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:30 PM Eastern Time. The TC2100's Customer Service number is (703) 306-5631.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene, can be reached on (703) 305-9790. The fax phone numbers for the organization where the application or proceeding is assigned are as follows:

703/872-9306

**(Official Communications)**

Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

sc   
Patent Examiner.  
September 13, 2004.